

yw



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,214	02/14/2002	Douglas M. Crockett	020200	3104

23696 7590 03/23/2005

Qualcomm Incorporated
 Patents Department
 5775 Morehouse Drive
 San Diego, CA 92121-1714

EXAMINER

DESIR, PIERRE LOUIS

ART UNIT	PAPER NUMBER
----------	--------------

2681

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,214

Applicant(s)

CROCKETT ET AL.

Examiner

Pierre-Louis Desir

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/23/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6781963. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the patent describes a method for terminating (i.e., removing) a user from a group call, wherein the method all the limitations of claim 1 of the application. The method further comprises sending a response to the user indicating the termination, which could represent an inherent disclosure

Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6781963. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of the patent discloses a computer-readable medium embodying a method in a communication device comprising terminating (i.e., removing) a member from an active group

call. The method comprises all the limitations of claim 2 of the application. The method further discloses sending a response to the user indicating the termination, which could represent an inherent disclosure.

Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6781963. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 3 of the patent discloses a communication device for terminating (i.e., removing) a member from a group call comprising all the limitations of claim 3 of the application. Claim 3 further discloses means for sending a response to the user indicating the termination, which could represent an inherent disclosure.

Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6781963. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 4 of the patent discloses a communication device for terminating (i.e., removing) a user from a group call. The method comprises all the limitations of claim 4 of the application. The method further includes sending a response to the user indicating that the user has been terminated from the group call, which could represent an inherent disclosure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2681

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5-7, 11-13, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuulos, U.S. Patent No. 5842136.

Regarding claim 1, Tuulos discloses in a communication device (i.e., subscriber station) (see abstract), a method for removing a member from an active group call in a group communication network (see abstract), the method comprising: receiving a member list from a user (i.e., to remove the desired subscriber stations from the call, the first subscriber station instructs the telecommunication network to remove one or more other subscriber stations from the call) (see abstract); and sending a request to a server to remove the member list from the active group call (i.e., the telecommunication network removes one or more other subscriber stations from the call without the call being interrupted) (see abstract).

Regarding claim 3, Tuulos discloses a communication device for removing a member from an active group call in a group communication network, comprising: means for receiving a member list from a user (i.e., to remove the desired subscriber stations from the call, the first subscriber station instructs the telecommunication network to remove one or more other subscriber stations from the call) (see abstract); and means for sending a request to a server to remove the member list from the active group call (i.e., the telecommunication network removes one or more other subscriber stations from the call without the call being interrupted) (see abstract).

Regarding claim 5, Tuulos discloses in a server (i.e. database) (see col. 2, line 28) a method for removing a member from an active group call in a group communication network (see abstract), the method comprising: receiving a request for removing a member list from an

Art Unit: 2681

active group call (i.e., to remove the desired subscriber stations from the call, the first subscriber station instructs the telecommunication network to remove one or more other subscriber stations from the call) (see abstract); and removing the member list from the active group call (i.e., the telecommunication network removes one or more other subscriber stations from the call without the call being interrupted) (see abstract).

Regarding claim 6, Tuulos discloses a method (see claim 5 rejection) further including announcing each member in the member list that they are being removed from the group call (i.e., the telecommunication network, 306, Infra transmits a removal or release message to the subscribers) (see col. 5, lines 63-64).

Regarding claim 7, Tuulos discloses a method (see claim 6 rejection), further including: receiving acknowledgement from each member in the member list (i.e., when the subscribers to be removed receive the removal or release messages, they transmit an acknowledgment message to the Infrastructure) (see col. 5, line 66 through col. 6, lines 1-2); and sending a response to the request, indicating that the member list has been removed (i.e., the Infra further transmits an acknowledgement to the A-subscribers D) (see col. 6, lines 2-3).

Regarding claim 11, Tuulos discloses a server (i.e., database) (see col. 2, line 28) for removing a member from an active group call in a group communication network, the method comprising: means for receiving a request for removing a member list from an active group call (i.e., to remove the desired subscriber stations from the call, the first subscriber station instructs the telecommunication network to remove one or more other subscriber stations from the call) (see abstract); and means for removing the member list from the active group call (i.e., the

Art Unit: 2681

telecommunication network removes one or more other subscriber stations from the call without the call being interrupted) (see abstract).

Regarding claim 12, Tuulos discloses a server (see claim 11 rejection), further including means for announcing each member in the member list that they are being removed from the group call (i.e., the telecommunication network, 306, Infra transmits a removal or release message to the subscribers) (see col. 5, lines 63-64).

Regarding claim 13, Tuulos discloses a server (see claim 12 rejection), further including: means for receiving acknowledgement from a member who wishes to participate in the group call (i.e., when the subscribers to be removed receive the removal or release messages, they transmit an acknowledgment message to the Infrastructure) (see col. 5, lines 22-39, and line 66 through col. 6, lines 1-2); and means for sending a response to the request, indicating that the member list has been removed (i.e., the Infra further transmits an acknowledgement to the A-subscribers D) (see col. 6, lines 2-3).

Regarding claim 17, Tuulos discloses a server (i.e., for removing a member from an active group call in a group communication network (see abstract), the server comprising: a dispatcher that receives a request for removing a member from an active group call based on a member list (see col. 2, lines 11-14); and a controller that removes the member based on the member list (see col. 2, lines 11-14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuulos in view of Jackson et al. (Jackson), U.S. Patent No. 6477387.

Regarding claim 2, Tuulos discloses in a communication device (see abstract) a method for removing a member from an active group call in a group communication network (see abstract). The method comprising receiving a member list from a user (i.e., to remove the desired subscriber stations from the call, the first subscriber station instructs the telecommunication network to remove one or more other subscriber stations from the call) (see abstract); and sending a request to a server to remove the member list from the active group call (i.e., the telecommunication network removes one or more other subscriber stations from the call without the call being interrupted) (see abstract).

Although Tuulos discloses a method as described above, Tuulos fails to specifically disclose a computer-readable medium (i.e., memory) embodying the method.

However, Jackson discloses a computer-readable medium (i.e., memory including ROM, RAM, PROM) (see col. 5, lines 8-12) embodying a method in a group communication.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both arts, which are analogous, to arrive at the claimed invention. A motivation for doing so would have been to ensure the proper execution of the process.

Regarding claim 8, Tuulos discloses in a server (i.e., database) (see col. 2, line 28), a method for a method for removing a member from an active group call in a group communication network (see abstract), the method comprising: receiving a request for removing a member list from an active group call (i.e., to remove the desired subscriber stations from the call, the first subscriber station instructs the telecommunication network to remove one or more other subscriber stations from the call) (see abstract); and removing the member list from the active group call.

Although Tuulos discloses a method as described above, Tuulos fails to specifically disclose a computer-readable medium (i.e., memory) embodying the method.

However, Jackson discloses a computer-readable medium (i.e., memory including ROM, RAM, PROM) (see col. 5, lines 8-12) embodying a method in a group communication.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both arts, which are analogous, to arrive at the claimed invention. A motivation for doing so would have been to ensure the proper execution of the process.

Regarding claim 9, Tuulos discloses a method (see claim 8 rejection and reasoning as related to the computer-readable medium) further includes announcing each member in the member list that they are being removed from the group call (i.e., the telecommunication network, 306, Infra transmits a removal or release message to the subscribers) (see col. 5, lines 63-64).

Regarding claim 10, Tuulos discloses a method (see claims 9 rejection, and claim 9 reasoning as related to the computer-readable medium) wherein the method further includes: receiving acknowledgement from a member in the member list who wishes to participate in the

Art Unit: 2681

group call (i.e., when the subscribers to be removed receive the removal or release messages, they transmit an acknowledgment message to the Infrastructure) (see col. 5, line 66 through col. 6, lines 1-2); and sending a response to the request, indicating that the member list has been removed (i.e., the Infra further transmits an acknowledgement to the A-subscribers D) (see col. 6, lines 2-3).

Claims 4, 14-16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuulos in view of Paanoven, U.S. Patent 5634197.

Regarding claim 4, Tuulos discloses a communication device for removing a member from an active group call in a group communication network (see abstract), the communication device comprising: receiving a member list from a user (i.e., to remove the desired subscriber stations from the call, the first subscriber station instructs the telecommunication network to remove one or more other subscriber stations from the call) (see abstract and col. 2, lines 11-14); and sending a request to a server to remove the member list from the active group call (i.e., the telecommunication network removes one or more other subscriber stations from the call without the call being interrupted) (see abstract and col. 2, lines 11-14).

Although Tuulos discloses a device as described, Tuulos fails to specifically disclose a device comprising a receiver, a transmitter, and a processor communicatively coupled to the receiver and the transmitter.

However, Paanoven discloses a subscriber station comprising a transceiver and a control unit communicatively connected to the transceiver (see col. 3, lines 22-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both arts, which are analogous to arrive at the claimed invention. A motivation for doing so would have been to ensure the proper execution of the removal procedure.

Regarding claim 14, Tuulos discloses a server (i.e. database) (see col. 2, line 28) for removing a member from an active group call in a group communication network (see abstract), the server comprising: receiving a request for removing a member list from an active group call (i.e., to remove the desired subscriber stations from the call, the first subscriber station instructs the telecommunication network to remove one or more other subscriber stations from the call) (see abstract and col. 2, lines 11-14); and removing the member list from the active group call (i.e., the telecommunication network removes one or more other subscriber stations from the call without the call being interrupted) (see abstract, and col. 2, lines 11-14).

However, Paanoven discloses a subscriber station comprising a transceiver and a control unit communicatively connected to the transceiver (see col. 3, lines 22-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both arts, which are analogous to arrive at the claimed invention. A motivation for doing so would have been to ensure the proper execution of the removal procedure.

Regarding claim 15, Tuulos discloses a server (see claim 14 rejection, and reasoning) comprising announcing each member in the member list that they are being removed from the group call (i.e., the telecommunication network, 306, Infra transmits a removal or release message to the subscribers) (see col. 5, lines 63-64).

Regarding claim 16, Tuulos discloses a server (see claim 15, rejection, and claim 14 reasoning) comprising receiving acknowledgement from a member who wishes to participate in the group call (i.e., when the subscribers to be removed receive the removal or release messages, they transmit an acknowledgment message to the Infrastructure) (see col. 5, lines 22-39, and line 66 through col. 6, lines 1-2); and sending a response to the request, indicating that the member list has been removed (i.e., the Infra further transmits an acknowledgement to the A-subscribers D) (see col. 6, lines 2-3).

Regarding claim 18, Tuulos discloses a server as described above (see claim 17 rejection).

Although Tuulos discloses a server comprising of a dispatcher as described, Tuulos fails to specifically disclose a server wherein the dispatcher determines location information for each member in the member list.

However, Paanoven discloses a controller comprising memory means, wherein information necessary for the operation of the mobile radio system is stored. This information may include information related to the location of the subscriber stations (see col. 6, lines 1-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to ensure the accurate location of the user so that secure service may be rendered.

Regarding claim 19, Tuulos discloses a server as described above (see claim 17 rejection).

Art Unit: 2681

Although Tuulos discloses a server as described, Tuulos fails to specifically disclose a server wherein the controller includes a local controller for a member that is located within a local region.

However, Paanoven discloses a controller, which includes a local controller for a member that is located within a local region (see col. 5, lines 44-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to ensure the accurate location of the user so that secure service may be rendered.

Regarding claim 20, Tuulos discloses a server (see claim 17 and 18 rejections) wherein the controller (i.e. dispatcher) includes a remote controller for a member that is located outside a local region (i.e., a dispatcher supervising the call, can add new subscribers. Thus, one skilled in the art would immediately envision that the new subscriber were located outside the local region, and the dispatcher served as a remote controller, so the new subscribers can be added in the group call.

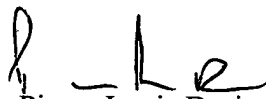
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Louis Desir whose telephone number is 703-605-4312. The examiner can normally be reached on 0800-1630.

Art Unit: 2681

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L Moise can be reached on (703) 306-0003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre-Louis Desir
AU 2681
03/18/2005

JEAN GELIN
PRIMARY EXAMINER

